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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,288	03/29/2000	Masao Okada	862.C1871	7078

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EXAMINER

HOTALING, JOHN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 06/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,288

Applicant(s)

OKADA ET AL.

Examiner

John M Hotaling II

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 11, and 13-16, drawn to animation display apparatus, classified in class 345, subclass 474.
 - II. Claims 17-13, drawn to a sticker printing apparatus and method, classified in class 700, subclass 233.
 - III. Claims 8-10, and 12, drawn to a game device, classified in class 463, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are (I) a animation display device which displays animation, (III) and a coin operated game machine are completely different from (II) a sticker printing apparatus and method which prints stickers.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the coin operated game machine

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does not require the specifics of the animation display device it merely has to have a display device. The subcombination has separate utility such the animation display device could be used for video animation such as making a movie or the like and does not need to be used in a coin operated video game.

The applicant's argues that the restriction requirements of Groups I, II, and III are not valid since the groups are all generally directed to the field of art concerning layered image data processing. The examiner contends that even though the groups may all generally be related, Groups I and III have been shown to be different than group II in function and groups I and III have been shown not to require the particular of the subcombination and has separate utility. Accordingly the restriction requirement is made final. It is requested that in any future amendment to the claims that the non-elected claims be canceled.

Claim Objections

2. Claims 27-31 objected to because of the following informalities: the claims use an abbreviation for operating system "OS" which should be defined the first time used in each series of independent claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 23 provides for the use of form of sticker called a Senjafuda or sashifuda, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass.

A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. In addition, the form of the Senjafuda with its parts is notoriously well known and has been practiced for hundreds of years.

Claims 21 and 23 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attenberg US Patent 5,913,019 in view of Drake et al US Patent 5,487,010. Attenberg discloses all of the instant application but does not specifically disclose the use of a virtual keyboard. Specifically Attenberg discloses in Column 2 a plurality of backgrounds, multiple images on the same sheet that may be peeled off separately, that the user may modify the image, a composite image. Columns 3 and 4 disclose the use of a keypad, keyboard and a touchscreen. Columns 5 and 6 disclose that the stickers may have a variety of intended uses and that electronic processing techniques

for composing a plurality of images is well known. Column 6:60-65 disclose that it is possible to eliminate the keypad and the functions performed by the keypad be installed in a touch screen. Column 7 discloses modifying the image and column 8 discloses a currency acceptor. Attenberg lacks in disclosing the use of a virtual keyboard used with a touch screen. However, Attenberg discloses the use of a keyboard and that it is well known to place the functions of a keypad, which is a simplified version of a keyboard, onto a touch screen. In an analogous invention to Drake discloses a bumper sticker making apparatus which discloses that a touch screen and a keyboard are analogous input devices in column 1:45-51. One of ordinary skill in the art would implement a virtual keyboard into the present machines given the motivation above that the functions of a keypad may be transferred to a touch screen and that a touch screen and a keyboard are analogous input devices. It would be obvious to one of ordinary skill in the art to implement a virtual keyboard in either of the references given the motivation provided above.

Citation of Pertinent Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Attenberg '581 discloses a photo manipulation kiosk

Rifkin et al '969 discloses a computer game for printing nail designs

Rifkin '906 disclose a method of producing stickers for toy vehicles

Huang et al '220 discloses a photo booth for forming sketches

Parry '232 discloses a customized wrapping paper kiosk

Hoyt et al '195 discloses a internet photo booth

Sakaguchi '627 discloses a garment image generator

Blank '179 discloses a image editing system

Davidson et al '123 discloses a custom card maker with a virtual keyboard

Carroll et al '960 discloses a virtual touch screen keyboard

Dwyer et al '211 discloses a virtual touch screen keyboard

JP 10-055489 discloses a sticker printing apparatus

Internet download "welcome to the world of SENJA-CARDS" discloses the history of Senja-Cards.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 3236 for regular communications and 703 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7777.

John M Hotaling II
June 11, 2003

